

AB



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/140,886	08/26/1998	HERBERT M. WILSON	N1205-003	9239
32905	7590	11/19/2004	EXAMINER	
JONDLE & ASSOCIATES P.C. 9085 EAST MINERAL CIRCLE SUITE 200 CENTENNIAL, CO 80112			FOX, DAVID T	
			ART UNIT	PAPER NUMBER
			1638	

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/140,886

Applicant(s)

WILSON ET AL.

Examiner

David T. Fox

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/8/2004 & 9/14/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 11/17/04
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Art Unit: 1638

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The Keller declaration of 14 September 2004 has obviated all art rejections of record except as indicated below.

Claims 1-22 remain rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific or substantial asserted utility or a well established utility, as stated on pages 2-3 of the last Office action.

Claims 1-22 also remain rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific or substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention, as stated in the paragraph bridging pages 3 and 4 of the last Office action.

Claims 1-22 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, as stated on page 4 of the last Office action.

Claims 1-22 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, as stated on page 4 of the last Office action.

Art Unit: 1638

Claims 1-22 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, as stated on page 4 of the last Office action.

Claims 1, 4, 6, 8, 11 and 13 remain rejected under 35 U.S.C. 102(b) as being anticipated by Zhou et al, as stated on page 4 of the last Office action.

Claims 2-3, 5, 7, 9-10, 12 and 14-22 are deemed free of the prior art, given the failure of the prior art to teach or reasonably suggest a method of transforming a plant species with a vector comprising uncharacterized genomic DNA from another plant species, for transmitting desired agronomic traits.

No claim is allowed.

Applicant's arguments filed 08 September 2004 have been fully considered but they are not persuasive.

Applicant urges that the utility rejection and how-to-use rejection under 35 USC 112, first paragraph, are improper, given the utility of improving agronomic characteristics in crop plants. The Examiner does not dispute the utility of the desired result of the claimed method, but maintains that no evidence has been provided to demonstrate that the method actually accomplishes what it intends.

Applicant urges that the written description rejection is improper, given the Wilson declaration of 07 January 2002 which demonstrates that Applicant is in possession of the claimed invention. The Examiner maintains that the Wilson declaration only demonstrated the obtention of a single plant species, namely corn, transformed with genomic DNA from another single species, namely sorghum, wherein

no change in agronomic traits were observed. Thus, the declaration does not provide the conserved structural features of the broadly claimed genus, and does not provide any structural features which are correlated with function, namely the expression of improved agronomic traits.

Applicant urges that the enablement rejection is improper, given the Stine and Wilson declarations cited previously. The Examiner maintains that these declarations do not provide the evidence necessary to refute the Examiner's position, as stated in the paragraph bridging pages 5 and 6 of the last Office action.

Applicant urges that the claims are definite, given the art-recognized definition of "uncharacterized" and "improved agronomic characteristics". The Examiner maintains that no such art-recognized definition of "uncharacterized" has been furnished by Applicant.

Applicant urges in the amendment of 08 September 2004 that the prior art references are all deficient for failing to provide molecular evidence of stable transformation, wherein said stability is an art-recognized aspect of "transformed", as stated in the Keller declaration of 14 September 2004. The Examiner has withdrawn all rejections except the one over Zhou et al, which appears to teach molecular probing techniques (see, e.g., page 248, middle paragraph). The Examiner will consider further arguments against Zhou et al.

During the Personal Interview of 17 November 2004, the Examiner discussed possible allowable subject matter and the submission of additional declaratory material

after the mailing of a final rejection. A copy of the Interview Summary Form was given to Applicant's representative.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (571) 272-0795. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (571) 272-0804. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight

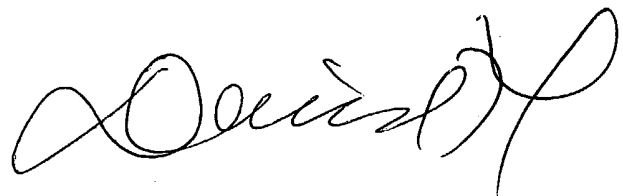
Art Unit: 1638

(EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

November 17, 2004

DAVID T. FOX
PRIMARY EXAMINER
GROUP 180 1638

A handwritten signature in black ink, appearing to read "David T. Fox", is written over the printed name and title.